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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,769	09/29/2000	Katsuhiko Takahashi	35.C14833	8654

5514 7590 04/09/2003

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NEW YORK, NY 10112

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/09/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-17

Office Action Summary

Application No.

09/672,769

Applicant(s)

TAKAHASHI ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsutsumi et al. (U.S. 6,031,019) in view of Suzuki et al. (U.S. 6,153,001) and either Tsang et al. (U.S. 5,886,065) or Johnson et al. (U.S. 5,922,118).

The rejection is adequately set forth in paragraph 4 of the office action mailed 11/8/02, Paper No. 15, and is incorporated here by reference.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 6,153,011) in view of Tsutsumi et al. (U.S. 6,031,019).

The rejection is adequately set forth in paragraph 5 of the office action mailed 11/8/02, Paper No. 15, and is incorporated here by reference.

Response to Arguments

4. Applicants' arguments filed 1/29/03 have been fully considered but they are not persuasive.

Specifically, applicants argue that the declaration filed 7/31/02 must be considered by the examiner in light of the ruling in *In re Chu*, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995) and the

teachings in MPEP 716.02(f) and MPEP 2144.08 II.B). Applicants further argue that *In re Davies*, 177 USPQ 381 (CCPA 1973), cited by the examiner, is not relevant to the present situation.

The cited portion of the MPEP and *Chu* both state that the totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made and that evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded.

It is noted that the examiner has considered the totality of the record including the declaration filed 7/31/02. However, in considering the totality of the record, it is noted that the results set forth in the declaration, namely that ink which comprises ethylene urea as presently claimed does not exhibit phase separation and thus exhibits superior storage stability, are not disclosed in the present specification. As set forth in *Davies*, “prima facie obviousness can be rebutted by evidence of unexpected properties of composition; however, basic property or utility must be disclosed in order for affidavit evidence of unexpected properties to be offered.” However, there does not appear to be any disclosure of phase separation or storage stability in the present specification. As noted in *Davies*, “affidavit evidence relating to after-discovered properties should not be considered in the instant application.”

It is significant to note that, as cited in *Davies*, the courts held that evidence of undisclosed advantages could be accepted if the advantages “would inherently flow” from what was discovered in the specification. However, the present specification states that the presently claimed ink is superior given that it does not exhibit intermittent ejection defect due to inhibition of increase in viscosity and film formation or solidification or exhibits minimal adhesion of

thickened ink to ejection port surface. Thus, the advantages of storage stability or phase separation do not appear to “inherently flow” from the advantages disclosed in the specification as originally filed. Further, applicants have not provided any evidence to show if or how the phase separation or storage stability as disclosed in the 1.132 declaration is related to the properties disclosed in the present specification.

Applicants argue that *Davies* is not relevant to the present situation. While it is agreed that in *Davies* applicants were attempting to establish criticality between homopolymers and copolymers, both of which were disclosed in the specification as suitable for use in the invention, this appears to be only one factor in *Davies*. Even with applicants attempt to make this distinction, the courts held that the reason the affidavit evidence filed by the applicants should not have been considered was that there was no disclosure in applicants’ specification regarding the unexpected properties set forth affidavit or any showing that the unexpected properties “would inherently flow” from what was disclosed in the specification. In light of this, it is the examiner’s position that *Davies* is relevant to the present situation.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

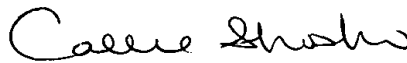
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Examiner
Art Unit 1714

CS
April 4, 2003